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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,003	06/27/2003	Ming H. Wu	MEM-0003	8421
23413	7590	03/06/2006		
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER MORILLO, JANELLE COMBS	
			ART UNIT	PAPER NUMBER
			1742	
DATE MAILED: 03/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary	Application No. 10/609,003	Applicant(s) WU, MING H.	
	Examiner Janelle Combs-Morillo	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 26-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>082405</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 56-000241A (JP'241) or Sagoi (US 4,253,873).

JP'241 teaches a Ti alloy with excellent impact resistance and tensile strength, said alloy comprising 2-5% Al, 1-9% Mo, 6.1-9.0% Cr, balance Ti (abstract). JP'241 further teaches examples that fall within the limits of instant claim 1 (see Table 1, ex. F and G). Because JP'241 teaches examples within the presently claimed range, it is held that JP'241 anticipates the instant invention.

Sagoi teaches a Ti based alloy comprising 2-5% Al, 1-9% Mo, 6.1-9% Cr, balance Ti (abstract). Sagoi further teaches examples in Table 1 within the presently claimed alloying ranges (Ex. 7, 8, 17, 18, 27, 28). Sagoi teaches heat treating and working said alloys to form a β phase structure, or an $\alpha+\beta$ phase structure (column 2 lines 39-55). Because Sagoi teaches examples within the presently claimed range, it is held that Sagoi anticipates the instant invention.

3. Claims 2-14 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP'241 or Sagoi.

JP'241 and Sagoi are discussed above.

Art Unit: 1742

Concerning the instant product by process limitations, JP'241 teaches heating to ~800°C (see Table 1). Sagoi teaches solution heating 760-800°C to achieve a beta phase structure or alpha + beta (column 2 lines 39-45), but does not teach the instant cold working step.

However, with regard to the process steps, it is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, differing only in the manner by which it is made, the burden falls to applicant to show that any process steps associated therewith result in a product materially different from that disclosed in the prior art. See MPEP 2113, *In re Brown* (173 USPQ 685) and *In re Fessman* (180 USPQ 524) *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292.

Concerning claims 3-11, 13, and 14, because JP'241 or Sagoi teach a substantially overlapping alloy composition, then substantially the same properties, such as elastic recovery are expected to be present. Where the claimed and prior art products are identical or substantially identical in structure or composition, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, if the prior art teaches the identical chemical

Art Unit: 1742

structure, the properties applicant discloses and/or claims are necessarily present.

Because the prior art teaches examples within the presently claimed alloying ranges, and wherein said prior art alloy appears to be substantially identical to the presently claimed alloy product, it is held that JP'241 or Sagoi anticipates, or on the alternative, has created a prima facie case of obviousness, of the presently claimed invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schetky et al (US 6,258,182).

Schetky teaches a beta phase titanium alloy preferably comprising: 10-12% Mo, 2.8-4% Al, 0-2% Cr, and 0-4% Nb (see abstract). Schetky teaches said alloy has linear elastic properties (column 4 line 16), pseudoelastic properties (column 3 line 14), superelastic properties (column 3 lines 27-28), and has a martensitic structure (abstract).

While the preferred range taught by Schetky does not overlap the alloys of amended claim 1 or claims 16 and 21, the alloys of claims 1, 16, and 21 fall within the scope of the limits of Mo, Al, Cr, V, and Nb listed in the examples of Schetky in Table III columns 7 and 8, wherein said examples encompass: 8.4-12% Mo, 2.3-3.7% Al, 0-1.8% Cr, 0-1.8% V, 0-3.8% Nb.

Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP §

Art Unit: 1742

2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Concerning the process limitations of dependent claims 2, 12, 17, 22, Schetky teaches cold working a wire up to 20% reduction, further heat treatment including solution heat treating 780-880°C (column 12 line 60), and aging at 200-400°C (column 11 lines 18) for 0.1-10,000 min (see Fig. 7), which meets the presently claimed product by process limitations.

Concerning claims 3-10, 13, 14, 18-20, 23, 24, because Schetky teaches a substantially overlapping alloy composition, processed in a substantially similar method, then substantially the same properties, such as elastic recovery are inherently present. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. The prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), see MPEP 2112.01.

Concerning claims 11 and 15, Schetky teaches said alloy has a beta phase (abstract) and is manufactured into a variety of useful articles, such as medical devices (abstract).

Because the prior art teaches an overlapping Ti-Mo-Al alloy processed in a substantially similar method, it is held that Schetky has created a prima facie case of obviousness of the presently claimed invention.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of copending Application No. 10/609004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'004 are also drawn to a composition with 8-10% Mo, 2.8-6% Al, up to 2% V, up to 4% Nb, balance Ti; wherein said alloy exhibits an elastic recovery substantially as presently claimed (see US'004 at claims 1-7), is produced by solution heating, cold working, cooling in air, aging 350-550°C (US'004 at cl. 2, 39, 43).

Art Unit: 1742

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/755034. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'034 are drawn to an overlapping alloy composition with 8-10% Mo, 2.8-6% Al, up to 2% V, up to 4% Nb, balance Ti (US'034 at cl. 4), wherein said alloy exhibits an elastic recovery substantially as presently claimed (see US'034 at claims 10-23), is produced an identical process of solution heating, cold working, cooling in air, aging 350-550°C (US'003 at cl. 6, 17, 31).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15-24 of copending Application No. 10/869359. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'359 are drawn to an overlapping alloy composition with 8-10% Mo, 2.8-6% Al, up to 2% V, up to 4% Nb, balance Ti (US'359 at cl. 17), wherein said alloy is held to inherently exhibit an elastic recovery substantially as presently claimed, and said alloy product is produced a process of heat treating and cold working (US'359 at cl. 15, 18).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/755085. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US'085 are drawn to an overlapping alloy composition with 8-10% Mo, 2.8-6% Al, up to 2% V, up to 4% Nb, balance Ti (US'085 at cl. 3), wherein said alloy exhibits an elastic recovery substantially as presently claimed (see US'085 at claims 5-10), is produced an identical process of solution heating, cold working, cooling in air, aging 350-550°C (US'085 at cl. 4, 45).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Amendment/Arguments

11. In the response filed on December 13, 2005 applicant amended claim 1 and submitted various arguments traversing the rejections of record. The examiner agrees that no new matter has been added.

12. The instant amendment has overcome the 102(b) rejection in view of Schetky.

13. Applicant's argument that the present invention is allowable over the prior art of record because JP'241 or Sagoi teach Cr and do not teach the presence of V or Nb, and therefore do not meet the instant alloy composition has not been found persuasive. The instant claims do not exclude Cr; and V and Nb are optional (therefore a teaching of an alloy without V or Nb meets said claim limitation). During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d

Art Unit: 1742

1023 (Fed. Cir. 1997). See MPEP §2111 - §2116.01. In doing so, the examiner has not read any limitations of the specification, or any preferred embodiment or example therein, into the claims unless there is basis in the claims or specification to do so. See generally, *Morris, supra*; *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978).

14. Applicant's argument that the present invention is allowable over the prior art of record because JP'241 or Sagoi do not teach cold working has not been found persuasive. As stated above, applicant has not shown that the product by process taught by the prior art is materially different than the presently claimed product by process.

Applicant's argument that the present invention is allowable over the prior art of record because Schetky does not teach examples within the claimed ranges has not been found persuasive. Patents are relevant as prior art for all they contain, and nonpreferred embodiments constitute prior art, MPEP 2123. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (The invention was directed to an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have "relatively acceptable dimensional stability" and "some degree of flexibility," but are inferior to circuit

Art Unit: 1742

boards impregnated with polyester-imide resins. The court upheld the rejection concluding that applicant's argument that the reference teaches away from using epoxy was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.).

Applicant has not shown unexpected strain recovery or shape memory recovery, etc., with regard to the overlapping composition taught by the prior art.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

Art Unit: 1742

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCM 
February 22, 2006


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700